REMARKS

Amendments to the Claims

Claim 26 has been amended in which the subject matter of claim 27 has been added to claim 26. No new matter has been added

Rejection Under 35 U.S.C. § 102

Claims 26 and 30 are rejected under 35 U.S.C. §102(e) as being anticipated by *Grow* U.S. Patent Number 6,694,315 (hereinafter *Grow*). Applicant respectfully traverses this rejection.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy these requirements.

Claim 26, as currently amended provides:

> 26. A computer-implemented method for enabling a legal entity to perform legal services for clients over a network, said method comprising the steps of:
> receiving an access identifier from a **client** into a program interface;
> authenticating said access identifier;
> displaying one **or more collections of case information** supplied by the **legal entity**, said case information being referenced to said client identifier;
> receiving a selection of said one or more collections of case information; and
> responsive to said selection, displaying specific client **case matter information**, wherein said client case matter information includes client billing information for enabling a legal entity to perform legal services for clients over a network.

As amended, claim 26 recites displaying "case matter information ... includ[ing] client billing information." *Grow* does not disclose displaying case matter information including billing information. *Grow* must teach every element of the claim to anticipate a

claim. See M.P.E.P. §2131. *Grow* merely discloses displaying an assembled document or docketing notification at a user workstation. Col. 1, l. 60 – Col. 2, l. 47. Applicant cannot find any aspect of *Grow* that displays billing information at the client program interface, as required by amended claim 26. Thus, Applicant respectfully asserts that *Grow* does not teach every element of claim 26 and is patentable over the 35 U.S.C. § 102 final rejection of record. Therefore, Applicant respectfully requests examiner withdraw the final the final rejection.

Furthermore, as shown above, claim 26 defines a method for enabling a legal entity to perform legal services for clients over the internet. *Grow* does not disclose at least this limitation. In fact, *Grow* does not disclose a method for *any entity* (legal or otherwise) to perform *services* for *a client*. *Grow* discloses a method for *an entity* (a user workstation 110) to provide services for the *same entity* (a user work station 110) using the internet (network backbone 120). Col. 2, ll. 14-34. Thus, *Grow* merely automates document assembly and docketing functions for a single legal entity. Col. 7, ll. 50-53; Col. 6, ll. 53-56 (disclosing an attorney logging onto the system and obtaining documents to create work product, nothing more). Under claim 26, however, a legal entity performs legal service and supplies case information to clients at the client program interface. Thus, *Grow* does not anticipate because it lacks the elements of a (1) a legal entity and (2) a separate client program interface. M.P.E.P. § 2131 ("The elements must be arranged as required by the claim.") *citing In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Accordingly, Applicant respectfully requests Examiner withdraw the final rejection.

While *Grow* discloses a host computer 150 sending client emails for notification purposes, see Col. 17, ll. 20, the host computer is not a "legal entity" and the host computer is not "perform[ing] legal services for clients," or displaying "collections of case information" or "case matter information" to clients as required by claim 26. To the contrary, *Grow* specifically states it does not perform legal services for clients. Col 7, ll. 2-3 ("[T]he web-site does not substitute for legal advice, etc."); Col. 14, l. 25. ("The disclaimers can be...warnings to seek legal advice."). Thus, it is indisputable that *Grow* does not provide the limitation of a legal entity performing legal services for clients, displaying collections of case information or displaying case matter information to clients. M.P.E.P. § 2131 ("The identical invention must be shown in as complete detail as is contained in the . . . claim") citing

Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). For these reasons, Applicant respectfully requests Examiner withdraw the final rejection.

Claim 30 depends from base claim 26, and thus inherits all limitations of claim 26. Claim 30 sets forth features and limitations not recited by *Grow*. Thus, the Applicant respectfully asserts that for the above reasons claim 30 is patentable over the 35 U.S.C. § 102 rejection of record.

Rejection Under 35 U.S.C. § 103(a)

Claims 28-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable in view *Grow* and further in view of *Bedell et al.*, U.S. Patent No. 6,622,128 (hereinafter *Bedell*). Applicant respectfully traverses.

Applicant respectfully submits that the previous discussion of the patentability of the subject over the combination of *Grow* and *Bedell* obviates the present rejection of these claims. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q. 2d, 1596 (Fed. Cir. 1988). Claims 28-29 depend at least in part from independent claim 26. Applicant asserts that because these are dependent claims, they are nonobvious over *Grow* in view of *Bedell*.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes that a fee of $200.00 is due with this response. However, if any additional fees are due, please charge Deposit Account No. 50-1078, under Order No. 70020550-2, from which the undersigned is authorized to draw.

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Respectfully submitted,

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